

ESTTA Tracking number: **ESTTA477874**

Filing date: **06/13/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Sazerac Company, Inc.
Granted to Date of previous extension	06/13/2012
Address	3850 N. Causeway Blvd., Suite 1695 Metairie, LA 70002 UNITED STATES
Attorney information	Lori F. Mayall Cooley LLP 777 6th Street, NW, Suite 1100 Washington, DC 20001 UNITED STATES trademarks@cooley.com, lmayall@cooley.com

Applicant Information

Application No	79101469	Publication date	02/14/2012
Opposition Filing Date	06/13/2012	Opposition Period Ends	06/13/2012
International Registration No.	1087799	International Registration Date	06/29/2011
Applicant	TOKIO INDUSTRY CO., LTD No.405 13-5, Nishisugamo 4-chome, Toshima-ku Tokyo 170-0001, JAPAN		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Japanese liquors; western liquors; whiskey; vodka; gin; bitters; brandy; rum; liqueurs; alcoholic fruit beverages; chinese liquors; flavored tonic liquors


Grounds for Opposition


Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3871259	Application Date	07/07/2009
Registration Date	11/02/2010	Foreign Priority Date	NONE

Word Mark	HIGHLAND STAG
Design Mark	 The logo for Highland Stag features the words "HIGHLAND STAG" in a large, bold, serif font. The letters are black with a subtle drop shadow effect, giving them a three-dimensional appearance.
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2010/06/22 First Use In Commerce: 2010/06/22 Scotch whisky

U.S. Registration No.	2765276	Application Date	01/03/2002
Registration Date	09/16/2003	Foreign Priority Date	NONE
Word Mark	GEORGE T. STAGG		
Design Mark	 The logo for George T. Stagg features the words "GEORGE T. STAGG" in a large, bold, serif font. The letters are black with a subtle drop shadow effect, giving them a three-dimensional appearance.		
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2002/11/00 First Use In Commerce: 2002/11/00 alcoholic beverages, namely, whiskey		

U.S. Registration No.	3679487	Application Date	02/24/2009
Registration Date	09/08/2009	Foreign Priority Date	NONE
Word Mark	GEORGE T. STAGG		
Design Mark	 The logo for George T. Stagg features a stylized antler design above the words "GEORGE T. STAGG". The antlers are drawn with simple, curved lines, and the text is in a bold, serif font. The entire logo is rendered in a light gray color.		
Description of Mark	The mark consists of the name "GEORGE T. STAGG" below an antler design.		
Goods/Services	Class 033. First use: First Use: 2002/11/00 First Use In Commerce: 2002/11/00		

	Whisky
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Attachments	77775732#TMSN.jpeg (1 page)(bytes) 76354856#TMSN.gif (1 page)(bytes) 77677295#TMSN.jpeg (1 page)(bytes) NOO re OLD STAG 6.13.12.pdf (5 pages)(63492 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/lfm/
Name	Lori F. Mayall
Date	06/13/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Serial No. 79/101,469
For the Trademark OLD STAG And Design
Published in the Official Gazette on February 14, 2012

SAZERAC COMPANY, INC.)	
)	
Opposer,)	
)	
v.)	Opposition No.
)	
TOKIO INDUSTRY CO., LTD)	
)	
)	
Applicant.)	
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NOTICE OF OPPOSITION

Opposer Sazerac Company, Inc. ("Sazerac"), a Louisiana corporation having its principal place of business at 3850 N. Causeway Blvd., Suite 1695, Metairie, Louisiana 70002, will be damaged by the issuance of a registration for the mark OLD STAG And Design ("Applicant's Mark"), as applied for in Application Serial No. 79/101,469 filed by Applicant Tokio Industry Co., Ltd, a Japanese corporation, located at Nishisugamo 4-chome, Toshima-ku, Tokyo 170-0001 Japan ("Applicant"). Sazerac, having previously been granted an extension of time to oppose Applicant's Mark, hereby opposes same.

As grounds for opposition, Sazerac alleges:

1. Sazerac markets and sells a number of different types and brands of alcoholic beverages and distilled spirits, including, without limitation, whiskey.
2. Sazerac owns the following United States trademark registrations:

HIGHLAND STAG, Registration No. 3,871,259 covering “Scotch whisky” in Class 033;

GEORGE T. STAGG, Registration No. 2,765,276 covering “alcoholic beverages, namely, whiskey” in Class 033; and



GEORGE T. STAGG And Design, Registration No. 3,679,487 covering “whiskey” in Class 033.

(collectively, “Sazerac’s Marks”).

3. Sazerac has consistently and continually marketed and distributed Scotch whisky under the HIGHLAND STAG mark since at least as early as June 22, 2010. Sazerac has consistently and continually marketed and sold its award winning whiskey under the GEORGE T. STAGG and GEORGE T. STAGG And Design marks since at least as early as November 2002. By virtue of its marketing and the excellence of the underlying products, the public has come to know, rely on, and recognize Sazerac’s Marks as a source identifier for Sazerac’s whiskey.

4. Sazerac produces and bottles whiskey and vodka at the Buffalo Trace Distillery, which prior to 1999, was known as the George T. Stag Distillery. The name “Stagg” has played an integral role in the Distillery’s history. In 1878 George T. Stag purchased the Distillery, then named the O.F.C. Distillery, and then renamed it The George T. Stag Distillery in 1904.

5. Upon information and belief, Sazerac alleges that on September 08, 2011 Applicant filed an application to register the mark OLD STAG And Design (Serial No. 79/101,469) in connection with “Japanese liquors; western liquors; whiskey; vodka; gin; bitters; brandy; rum; liqueurs; alcoholic fruit beverages; chinese liquors; flavored tonic liquors,” requesting for extension of protection of its International Registration to the United States under Section 66(a). There is no issue as to priority because Applicant’s priority date is June 29, 2011.

6. Applicant's Mark is likely to be confused with and mistaken for Sazerac's whiskey products marketed under Sazerac's Marks because Applicant's Mark is confusingly similar in sight and sound to Sazerac's Marks. Applicant's OLD STAG mark and Sazerac's Marks share the identical dominant word component "STAG." Given Sazerac has multiple "STAG" variant marks for its whiskey, consumers will undoubtedly believe Applicant's OLD STAG alcoholic beverages are offered by Sazerac and not the Applicant.

7. Applicant's Mark is used in connection with products that are identical to Sazerac's products, namely, distilled spirits. Thus, Applicant's Mark will be used in connection with products that overlap with, and are related to, Sazerac's products.

8. Applicant's targeted customer base overlaps with the customers and consumers of Sazerac's alcoholic beverages.

9. As Applicant's goods description contains no restrictions or limitations as to Applicant's channels of trade, Sazerac may assume that Applicant's Mark, like Sazerac's Marks, will be used in all accepted channels of trade. Therefore, in addition to overlapping consumer bases, Applicant's channels of trade for its alcoholic products overlap with the channels of trade used by Sazerac in marketing, selling, and otherwise distributing its whiskey.

10. If Applicant is permitted to register its OLD STAG mark (Serial No.79/101,469) for the various alcoholic beverages identified in the Application herein opposed, confusion resulting in damage and injury to Sazerac would likely occur. Persons familiar with Sazerac's Marks would likely perceive Applicant's products as associated, affiliated with, or sponsored by Sazerac. Such confusion would inevitably result in damage to Sazerac.

11. Sazerac's customers and the relevant public are likely to misapprehend Applicant's Mark as a Sazerac mark rather than a mark of Tokio Industry Co., Ltd and/or believe

in error that goods offered under the Applicant's OLD STAG mark (Serial No. 79/101,469) are offered by, in association with, or under license from Sazerac.

12. Any defect, objection to or fault found with Applicant's goods marketed under its OLD STAG mark (Serial No. 79/101,469) would necessarily reflect on and seriously injure the reputation that Sazerac has established for its alcoholic beverage and distilled spirits products.

13. Registration of Applicant's Mark would give Applicant *prima facie* evidence of the validity and ownership of Applicant's Mark and of Applicant's exclusive right to use its OLD STAG mark, all to the detriment of Sazerac.

14. Wherefore, Sazerac prays that this Opposition be sustained and that Application Serial No. 79/101,469 be denied and refused registration.

Date: June 13, 2012

COOLEY LLP

By: 

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Todd S. Bontemps, Esq.
Attorneys for Opposer
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CERTIFICATE OF SERVICE

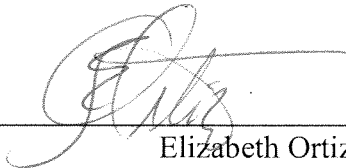
I hereby certify that on June 13, 2012, I mailed the foregoing NOTICE OF OPPOSITION to Counsel for Applicant as well as Applicant by depositing a true and correct copy of the same with the United States Postal Service, first class mail, postage prepaid, in an envelope addressed to:

Yoon S. Ham
Lowe Hauptman Ham & Berner LLP
Suite 300
1700 Diagonal Road
Alexandria VA 22314

and

Tokio Industry Co., Ltd
No.405 13-5, Nishisugamo 4-chome, Toshima-ku
Tokyo 170-0001
Japan

Date: June 13, 2012


Elizabeth Ortiz

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